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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,856	02/13/2004	Daniel A. Tepei	1988480	6136
22824	7590	03/18/2005	EXAMINER	
DONALD R. SCHOONOVER 4211 ROLLING HILLS DRIVE NIXA, MO 65714-8771				FULTON, CHRISTOPHER W
		ART UNIT		PAPER NUMBER
		2859		

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/777,856	TEPEI, DANIEL A.	
	Examiner	Art Unit	
	Christopher W. Fulton	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 January 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 13 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dempsey in view of Defenbaugh, Rigaumont, Roman, Polselli et al, and Kuechenmeister.

The device as claimed is substantially disclosed by Dempsey with a T-shaped body with a handle 36 on the head portion and a plurality of slots along the transverse portion of the T-shaped body to accommodate a marker, but lacks the top surface of the head portion and the transverse portion being along a single plane, indicia on the transverse portion adjacent the slots, a plurality of roller bearings in the contact edge of the head portion, the slots being notches exposed along an edge of the transverse portion of the body, the handle being U-shaped, and a groove along the edge of the transverse portion to accommodate the users fingers to aide in holding the device.

Defenbaugh teaches making the top surface of a head portion and transverse portion of a marking device in the same plane for a smooth marking plane along the edges of the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the top surface of the head portion and the transverse portion being along a single plane in Dempsey as taught by Defenbaugh to make a smooth marking surface along the edges of the device.

Defenbaugh also teaches using indicia on the transverse portion adjacent notches to aide in locating the marking implement in the desired notch. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place indicia on the transverse portion adjacent the slots in the device of the combination of Dempsey and Defenbaugh as further taught by Defenbaugh to better locate the marking implement in the desired slot.

Rigaumont teaches using roller bearings on the contact surfaces of a drafting device to aide in moving the device along the workpiece. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use roller bearings in the combination of Dempsey and Defenbaugh together as taught by Rigaumont to smooth the movement of the device along the workpiece.

Roman teaches using notches exposed along an edge of the transverse portion of the body to easily engage the marking implement from the open end of the notch. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the slots of the combination of Dempsey, Defenbaugh, and Rigaumont to the edge of the transverse arm of the body as taught by Roman to easily engage the marking implement from the open end of the notches.

Polselli et al teaches using a U-shaped handle to move a marking device which is easily grasped by the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the handle of the combination of Dempsey, Defenbaugh, Rigaumont, and Roman U-shaped as taught by Polselli et al to make the handle easily holdable by the user.

Kuechenmeister teaches using a groove 23 along the edge of a member to engage the fingers of the user to aide in holding the device during use of the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a groove along the edge of the transverse member in the combination of Dempsey, Defenbaugh, Rigaumont, Roman, and Polselli et al as taught by Kuechenmeister to aide in holding the device during use of the device.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dempsey, Defenbaugh, Rigaumont, Roman, Polselli et al, Kuechenmeister as applied to claim 1 above, and further in view of Granger.

The device as claimed is disclosed by the combination of Dempsey, Defenbaugh, Rigaumont, Roman, Polselli et al, and Kuechenmeister as stated in the rejection recited above for claim 1, but lacks the workpiece being marked specifically being drywall.

Granger teaches using a T-shaped marking device to mark drywall. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the device of the combination of Dempsey, Defenbaugh, Rigaumont, Roman, Polselli et al, and Kuechenmeister to mark drywall as taught by Granger to trim the drywall to the desired size.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dempsey in view of Rigaumont, Roman, and Polselli et al.

The device as claimed is substantially disclosed by Dempsey with a T-shaped body with a handle 36 on the head portion and a plurality of slots along the transverse portion of the T-shaped body to accommodate a marker, but lacks a plurality of roller

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bearings in the contact edge of the head portion, the slots being notches exposed along an edge of the transverse portion of the body, and the handle being U-shaped.

Rigaumont teaches using roller bearings on the contact surfaces of a drafting device to aide in moving the device along the workpiece. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use roller bearings in Dempsey as taught by Rigaumont to smooth the movement of the device along the workpiece.

Roman teaches using notches exposed along an edge of the transverse portion of the body to easily engage the marking implement from the open end of the notch. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the slots of the combination of Dempsey and Rigaumont to the edge of the transverse arm of the body as taught by Roman to easily engage the marking implement from the open end of the notches.

Polselli et al teaches using a U-shaped handle to move a marking device which is easily grasped by the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the handle of the combination of Dempsey, Rigaumont, and Roman U-shaped as taught by Polselli et al to make the handle easily holdable by the user.

Response to Arguments

5. Applicant's arguments filed January 28, 2005 have been fully considered but they are not persuasive.
6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). With respect to the Dempsey reference having a knob shaped handle which requires two hand operation with one hand on the knob and the other on the marking implement and applicants invention having a U-shaped handle which provides control with a one hand operation, the argument is not persuasive because;

- a. the Dempsey reference is argued individually and the Polselli et al reference is used to teach the U-shaped handle
 - b. the described one hand operation of applicants invention involves one hand on the handle to free up the other hand for controlling the marking implement which is the same operation as described by applicant in describing the two hand operation of the Dempsey reference.
7. In response to applicant's argument that Polselli et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Polselli et al reference even though not for marking drywall is in the field on endeavor of guiding a marker spaced from and guided by a reference edge and also reasonably pertinent to the problem of controlling a marking device that is guided along a reference edge by use a handle.
8. In response to applicant's argument that the groove of Kuechenmeister reference is used for a finger guide among other functions, but not a finger rest for a reference

point as in applicants invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher W. Fulton whose telephone number is (571) 272-2242. The examiner can normally be reached on M-Th 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher W. Fulton
Primary Examiner
Art Unit 2859

CWF